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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,939	06/15/2005	Gerardus Maria Van Erp	235761	3642
23460	7590	04/20/2006		
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780				
			EXAMINER SZEKELY, PETER A	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,939	<b>Applicant(s)</b> VAN ERP, GERARDUS MARIA	
	<b>Examiner</b> Peter Szekely	<b>Art Unit</b> 1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/15/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-21 in the reply filed on 3/13/06 is acknowledged. The traversal is on the ground(s) that Groups I-III share a special technical feature and that there would be no extra burden on the examiner. This is not found persuasive because claim 1 does not provide a contribution over the prior art, see Hayes 6,057,389, and the examination of Groups II and III would include searching classes 427 and 428, while claims 1-21 are searchable in classes 523 and 524.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 10/534,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions in both applications are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 8, 9 and 15-21 are rejected under 35 U.S.C. 102(b or e) as being anticipated by Washabaugh et al. 4,314,919, Ellenberger et al. 5,252,636, Theodore 4,451,605, Parish et al. 5,371,117, Parish et al. 5,373,036, Harrison 6,403,222 or Koshy 6,451,876.

6. Washabaugh et al. disclose unsaturated polyester and colloidal clay in claim 1, bentonite in claim 4, talc, hollow glass microspheres and fumed silica in Example 2. Ellenberger et al. teach sand in claim 4, silica fume, fly ash aggregate and reactive resin in claims 6-7 and epoxy resin in claim 8. Theodore recites polyurethane and talc in claim 1, hollow glass bubbles in claim 3 and fumed silica in the Examples. For volume %-s, see the paragraph overlapping columns 3 and 4. Parish et al. ('117) divulge vinyl

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ester resin, calcium carbonate or talc, fumed silica, thixotropic clay and hollow glass microspheres in claim 1. Parish et al. ('036) show the same formulation with unsaturated polyester. Harrison reveals resin and hollow glass microspheres in claim 1, fibers, wollastonite calcium carbonate and mica in claim 13, fumed silica in claim 15 and concentrations in claim 20. Koshy displays epoxy resin, hollow inorganic microspheres, and thixotropic agent in claim 12, and fillers in claims 29-30. For fumed silica, see column 6, lines 30-31. The specific gravities are inherent in the composition. Polymer concrete is the intended use and as such it has no patentable significance. Applicant's claims are not novel.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washabaugh et al. 4,314,919, Ellenberger et al. 5,252,636, Theodore 4,451,605, Parish et al. 5,371,117, Parish et al. 5,373,036, Harrison 6,403,222 or Koshy 6,451,876, in view of Simmons et al. 4,616,050 or Kim 5,498,683.

9. The primary references have been discussed already. Simmons et al. describe unsaturated polyester in claim 1, sand in claim 3, basalt and fly ash and their mixtures in column 9, lines 46-55. Kim relates vinyl esters in claim 1 and a combination of basalt and fly ash in column 6, lines 33-41. It would have been obvious to one having ordinary

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skill in art; at the time the invention was made, to use basalt as the heavy aggregate since it is customarily used in polymer cements and adhesives. No rock can be used as aggregate unless it is crushed. There is no criticality assigned to the particle size of the basalt, therefore it is obvious too. All properties are inherent in the composition.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In order to have a polymer concrete the polymers used have to be thermosetting. Otherwise the polymer concrete would soften with heat. Therefore, the polyester has to be an unsaturated polyester and the polyurethane has to be a crosslinkable polyurethane. Crosslinkers, hardeners, initiators, catalysts etc. are also required. One of ordinary skill in the art would not know from the specification which polyesters, vinyl esters, epoxy or polyurethane resins are suitable for the application and which are not.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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13. Claims 5-7 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 5 is rendered indefinite by the word "usually". What is the concentration in an unusual case? Claim 21 contains improper Markush language. Claims 6 and 7 claim "centre spheres". The examiner does not know what "centre spheres" are and he cannot find any reference to them either. Applicant is requested to supply the definition of said, "centre spheres".

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Peter Szekely', with a stylized flourish at the end.

Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
4/17/06